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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,166	04/01/2004	Donald A. Smith	643-1-001	2738
20551	7590	04/19/2007	EXAMINER	
THORPE NORTH & WESTERN, LLP. 8180 SOUTH 700 EAST, SUITE 200 SANDY, UT 84070			TILL, TERRENCE R	
		ART UNIT	PAPER NUMBER	
		1744		
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/19/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/817,166	SMITH, DONALD A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Terrence R. Till	1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 and 16-25 is/are rejected.
- 7) Claim(s) 14 and 15 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/04, 10/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: In paragraph 0001 of the specification, please update the status of application 10/055,857 as being patent 6,826,799.

Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7, 11-13, 16, 17, 19 22 and 23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3 and 20 of U.S.

Patent No. 6,826,799 in view of Pettit et al. (US 2,822,061) and Von Stackelberg (US 6,767,380).

4. With respect to claims 1-7, 11-13, 16, 17 and 19 of the present application, claims 1 and 20 of the '799 patent disclose verbatim the subject matter of "1. A vacuum cleaning device

powered by compressed air, comprising: an elongate canister having a top end, a bottom end, and an internal chamber; an elongate handle secured to the canister and extending above the top end of the canister and by which the canister can be held and manipulated; a venturi and nozzle assembly in fluid flow communication with the top end of the internal chamber adapted to be connected to a source of compressed air whereby compressed air is directed from the nozzle through the venturi to create a vacuum in the internal chamber and having an outlet for air passing through the venturi; a vacuum intake pipe secured to the canister and extending below the bottom end of the canister and into the chamber terminating in fluid flow communication with the chamber intermediate the top and bottom of the chamber; a baffle deflector in the chamber arranged with respect to the termination of the vacuum intake pipe to deflect air and any debris and liquid entering the chamber from the vacuum pipe downwardly toward the bottom of the chamber" as recited in claim 1 of the present application. The '799 patent does not disclose a drain opening for draining liquid and debris from the chamber; means for closing the drain opening to prevent liquid and debris in the chamber from draining through the drain opening; and user operated means for opening the drain opening when desired to drain liquid and debris from the chamber. However, the patent to Pettit et al. discloses a vacuum cleaning device that includes a drain opening 13 for draining liquid and debris from the chamber; means for closing the drain opening 14 (plug) to prevent liquid and debris in the chamber from draining through the drain opening; and user operated means 15, 17-22, for opening the drain opening when desired to drain liquid and debris from the chamber. This user operated means includes a spring 23, shaft 15, 17-19 and handle 22, where the handle and spring are mounted to the top of the canister and the user pushes down on the handle against the force of the spring to empty the container. It

would have been obvious to a person skilled in the art at the time the invention was made to provide claims 1 and 20 of the '799 patent with a drain opening for draining liquid and debris from the chamber; means for closing the drain opening to prevent liquid and debris in the chamber from draining through the drain opening; and user operated means for opening the drain opening when desired to drain liquid and debris from the chamber in view of the teaching to Pettit et al. in order to easily and conveniently drain the canister when full. With respect to claims 11-13, 16, 17, claims 2 and 3 of the '799 patent discloses a filter around the outlet for air passing through the venturi wherein the filter is a vacuum cleaner bag removably positioned around the outlet. These limitations are considered to read on the limitations of claims 11-13 and 16. With respect to claim 17, the recitation of the filter acting as a muffler does not distinguish itself from claims 2 and 3 of the '799 patent as such is not a structural limitation, but the manner that the claimed invention is intended to be used.

5. With respect to claims 8-10, 22 and 23 of the present application, claims 1 and 20, as modified by Pettit et al., do not disclose including a conduit extending into the chamber through which liquid can be pumped from the chamber, the conduit is adapted to be connected to a liquid pump and the conduit extends through the top of the canister into the chamber. The patent to Von Stackelberg discloses a vacuum cleaning device that has a conduit extending 51b into the chamber 18 through which liquid can be pumped from the chamber, the conduit is adapted to be connected to a liquid pump 56 and the conduit extends through the top of the canister into the chamber (see figure 10). It would have been obvious to a person skilled in the art at the time the invention was made to provide claims 1 and 20, as modified by Pettit et al., with a conduit extending into the chamber through which liquid can be pumped from the chamber, the conduit

is adapted to be connected to a liquid pump and the conduit extends through the top of the canister into the chamber in view of the teaching of Von Stackelberg so that the draining can be done on a continuous basis, without need to stop to drain the canister.

6. Claim 21 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 20 of U.S. Patent No. 6,826,799 in view of Von Stackelberg (US 6,767,380).

7. Claims 1 and 20 of the '799 patent disclose verbatim the subject matter, as seen above, but do not disclose a conduit extending into the chamber through which liquid can be pumped from the chamber, the conduit is adapted to be connected to a liquid pump and the conduit extends through the top of the canister into the chamber. The patent to Von Stackelberg discloses a vacuum cleaning device that has a conduit extending 51b into the chamber 18 through which liquid can be pumped from the chamber, the conduit is adapted to be connected to a liquid pump 56 and the conduit extends through the top of the canister into the chamber (see figure 10). It would have been obvious to a person skilled in the art at the time the invention was made to provide claims 1 and 20 with a conduit extending into the chamber through which liquid can be pumped from the chamber, the conduit is adapted to be connected to a liquid pump and the conduit extends through the top of the canister into the chamber in view of the teaching of Von Stackelberg so that the draining can be done on a continuous basis, without need to stop to drain the canister.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Pettit et al. (US 2,822,061).

10. Pettit et al. is considered to disclose all the recited subject matter of a drain opening 13 for draining liquid and debris from the chamber; means for closing the drain opening 14 (plug) to prevent liquid and debris in the chamber from draining through the drain opening; and user operated means 15, 17-22, for opening the drain opening when desired to drain liquid and debris from the chamber. This user operated means includes a spring 23, shaft 15, 17-19 and handle 22, where the handle and spring are mounted to the top of the canister and the user pushes down on the handle against the force of the spring to empty the container.

11. Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Von Stackelberg (US 6,767380).

12. Von Stackelberg discloses a vacuum cleaning device that has a conduit extending 51b into the chamber 18 through which liquid can be pumped from the chamber, the conduit is

adapted to be connected to a liquid pump 56 and the conduit extends through the top of the canister into the chamber (see figure 10).

*Allowable Subject Matter*

13. Claims 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

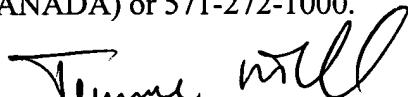
15. The patents to Breton and Grey show liquid vacuuming devices having vacuum intake pipes and deflectors deflecting liquid downwardly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terrence R. Till whose telephone number is (571) 272-1280. The examiner can normally be reached on Mon. through Thurs. and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys P. Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1744

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Terrence R. Till  
Primary Examiner  
Art Unit 1744

trt